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MAY 07 2003

OFFICE OF PETITIONS

In re Application of
Charles E. Hill
Application No. 09/618,744
Filed: July 18, 2000
For: Electronic Catalog System And Method

Decision
Dismissing Petition

A petition for access was filed on November 4, 2002, requesting access to the above-identified application. In response to a three week letter mailed March 5, 2003, applicants filed papers on March 26, 2003 opposing the access request

A member of the public may be entitled to access if "special circumstances" are shown which warrant a grant of access under 35 U.S.C. § 122. See Manual of Patent Examining Procedure (MPEP), Section 103.

Petitioner states that the above-identified application relies upon the filing date of the application that issued as U.S. Patent No. 5,528,490, as did the applications that became U.S. Patent Nos. 5,754,864, 5,761,649, and 6,131,088 and 6,029,142 in that they all claim directly or indirectly benefit of the filing date of the application that became the '490 patent. Petitioner urges that the file wrapper contents of the above referenced application may be useful for interpreting the claims in all of the continuing cases that became patents. Petitioner also alleges that prior art may have been moved to the above referenced application file from the applications that resulted in the five patents and requests access to that prior art.

In response to the petition applicant urges that access should be denied because it is not allowed by rule, and litigation is not a special circumstance. Applicant also argues that access should be controlled by the court in litigation.

A petition for access must show "special circumstances" which warrant a departure for the confidentiality normally given to patent applications. Manual of Patent Examining Procedure, Section 103 explains the circumstances that have been found to be such a "special circumstance," for example, where an application claims the benefit of an application under 35 U.S.C. § 120.

The special circumstances alleged in the petition are that the contents of the application maybe useful in litigation of related applications. The petition and applicants' response thereto establish that the necessity for access to the above referenced application is a matter before the court in the referenced litigation.

When a matter is in litigation, the PTO generally leaves the decision as to whether and under what conditions one litigant should have access to another's application up to the discretion of the court in which the matter is being addressed. No "special circumstances" have been identified which would warrant not deferring to the court's discretion in the matter in litigation.

With respect to transferred prior art, Michael L. Lewis of this office inspected the above referenced application and could not find any prior references in the application file that had been transferred from any other application.

The request is DISMISSED, but maybe renewed if litigation is terminated and petitioner provides evidence to establish special circumstances that warrant access to the application beyond the matter that is currently being litigated.

Telephone inquiries concerning this decision should be directed to Michael L. Lewis at (703) 306-5585.

Karin Ferriter

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